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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Rajko Milovanovic

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TEXAS INSTRUMENTS INCORPORATED

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2421

NOTIFICATION DATE

DELIVERY MODE

08/31/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@ti.com

Office Action Summary	Application No. 09/923,232	Applicant(s) MILOVANOVIC ET AL.	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34, 46, 49, 52 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34, 46, 49, 52 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2421

DETAILED ACTION

1. This action is responsive to amendment filed May 4, 2009.
2. Claims 34, 46, 49, 52 and 55-58 are pending. Claims 34, 46, 49 and 52 are independent claims.

Response to Amendments

3. Per Applicants' request, Claims 1, 10, 12 and 29 have been canceled.

Response to Arguments

4. Applicants' arguments have been fully considered but they are not persuasive. The following is an examiner's response to Applicants' arguments.

Applicants' arguments

The OFFICE ACTION states at: page 6, lines 5 to 14; page 6, line 24 to page 7, line 7; page 7, line 19 to page 8, line 2; and page 8, lines ii to 21:

"control keys including an activation key operable to activate a remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller i0 is inactive or in a sleep mode - no signal is sent from or received by the remote controller i0 - but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed control keys including an activation key i.e., key 14 operable to activate a remote control device is considered met by key 14)"

This argument by the Examiner is remarkable in that it fails to point out the portions of Boyd et al teaching the points argued. The Applicants submit that Boyd et al does not teach "without a user positioning over the select button 14, the remote controller i0 is inactive or in a sleep mode - no signal is sent from or received by the remote controller i0." Without tying this rejection to the teachings of Boyd et al this rejection fails to comply with the requirements of 37 CFR §1.104(c) (2). The text of 37 CFR §1.104(c) (2) states:

"(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

The Applicants respectfully submit that there is no teaching in Boyd et al to support this rejection. This application states at page ii, lines 21 to 23:

"In another preferred embodiment, the finger print apparatus 26 is incorporated on the remote control device 41 as an 'activate remote' key that must be pressed in order for the remote to start functioning."

Thus according to the language of claims 34, 46, 49 and 52 and as taught in the application, the remote control requires the activation key including the fingerprint sensor to be pressed to start functioning. Boyd et al does not teach this subject matter. Figure 1 of Boyd et al illustrates plural buttons. In the absence of teaching in Boyd et al to believe otherwise, pressing

Art Unit: 2421

any of these other buttons would cause the remote to operate to send a signal to the controlled device. The OFFICE ACTION fails to point out where Boyd et al teaches pressing button 14 is necessary for other operations of remote control i0. Accordingly, claims 34, 46, 49 and 52 are allowable over Boyd et al.

Examiner's response

In response to Applicants' arguments that the rejection of the claims fails to comply with the requirements of 37 CFR 1.104(c)(2), especially with respect to the requirements for "[t]he pertinence of each reference, if not apparent, must be clearly explained ...", the Office respectfully notes that the portion of the Office action cited by Applicants appears to just comply with the requirement with detailed explanation of the Office's interpretation of how Boyd invention anticipate the claimed invention in view of the claim language.

Applicants further submitted that Boyd does not teach that "the remote control requires the activation key including the fingerprint sensor to be pressed to start functioning."

In response to Applicants' argument, it is respectfully noted that the claim language does not explicitly requires that the fingerprint sensor **be pressed** for the remote control to start functioning. Rather, the claim language merely requires "an activation key operable to activate a remote control device."

The claimed "activation key" is interpreted to mean Boyd's key 14 (e.g., 2:1-51, "an image of the user's fingerprint may be captured **when** the user's finger is positioned over the select button 14" and the image captured will be transmitted to a processor-based system for starting the process shown in FIG. 3, steps 34-40).

The claimed "operable" is interpreted to mean "fit" or "practicable" (see definition 1 in Merriam-Webster's Online Dictionary). According to this definition, there is no hint of an act of "pressing" as alleged by Applicants.

The claimed "to activate" is interpreted to mean to start the process of capturing and checking the fingerprint image as discussed previously.

The claimed "remote control device" is interpreted to mean two possible devices:

Art Unit: 2421

1) the “remote control” device which contains the activation key – with this interpretation, “a remote control device” should be changed to -- the remote control device -- and “[a] device” recited in the preamble should be changed to -- [a] remote control device – to give proper antecedent basis to -- the remote control device -- at line 8 of the claim. With the suggested amended claim language, the remote control device is clearly and distinctly defined to be the device that contains the activation key. In view of this interpretation, the requirement of the claimed “remote control device” is considered met by Boyd’s remote control device 10.

2) the claimed “[a] remote control device” can also be interpreted to mean a control device, e.g., a controller or processor in a television set or set top box, located remotely from the remote control device that contains the activation key. Even in view of this interpretation, the requirement of the claimed “remote control device” is considered met by Boyd’s invention of a remote control device 10 activating a remote TV set after validation of the user’s fingerprint.

In view of the foregoing discussion, Claims 34, 46, 49 and 52 and its dependent claims are not considered allowable over Boyd, taken alone or in combination with Nykerk.

Claim Rejections – 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2421

6. Claims 34, 46, 49 and 52 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,850,632 to Boyd et al. ("Boyd").

It should be noted that hereinafter the use of the clause "see at least" should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

Claim 34

Boyd discloses *a device* (see at least FIGs. 1-2, device 10) *comprising:*

a housing (see at least FIGs. 1-2, device 12);

electronic circuitry disposed within the housing (see at least FIG. 2, circuit 26);

a signal transmitter disposed within the housing (see at least FIG. 5, device 26; 2:22-31; it is noted that in order to wirelessly convey information about the image captured by the sensor to the processor-based system 42, the device 26 must necessarily comprise a transmitter-receiver without which the information transmitting and receiving would be inoperative);

a plurality of control keys disposed on an outer surface of the housing, at least some of the control keys operable by hand (see at least FIGs. 1-2, the control keys shown on the surface of device 12), *the control keys including an activation key operable to activate a remote control device* (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 - but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed *control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device* is considered met by key 14); *and*

Art Unit: 2421

a fingerprint sensor integrated within the activation key (see at least FIG. 2, components 14, 20, 22, 24, 25, 26).

Claim 46

Boyd discloses *a system for user recognition and customized content provisioning (see at least FIGs. 1-2, 5), the system comprising:*

a remote control device having a plurality of control keys (see at least FIGs. 1-2, device 10), the remote device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of user's finger (see at least FIGs. 1-2, key 14),

said control keys include an activation key operable to activate the remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 - but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device is considered met by key 14), and said fingerprint sensor is embedded in the activation key (see at least FIGs. 1-2, key 14); and

an apparatus capable of presenting customized content to the user controllable by activation of said plurality of control keys, the customized content selected dependent upon said fingerprint data of the user's finger (see at least 3:23-4:44).

Claim 49

Art Unit: 2421

Boyd discloses *an apparatus for content provisioning* (see at least FIGs. 1-2, 5) *comprising:*

means for acquiring data related to a user without active user input or participation (see at least FIGs. 1-2, key 14), *the means for acquiring data including a remote control device having a plurality of control keys* (see at least FIGs. 1-2, device 10) *and a fingerprint sensor embedded in one of the control keys, whereby activation of said one of said control keys reads fingerprint data of a user's finger* (see at least FIGs. 1-2, key 14), *said control keys include an activation key operable to activate the remote control device* (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 – but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed *control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device* is considered met by key 14), *and said fingerprint sensor is embedded in the activation key* (see at least FIGs. 1-2, key 14); *and*

means for presenting customized content to the user controllable by activation of said plurality of control keys, said customized content selected in response to said fingerprint data of the user's finger (see at least 3:23-4:44).

Claim 52

Boyd discloses *a television system* (see at least FIG. 5; Abstract, lines 8-10) *comprising:*

a remote control device having a plurality of control keys, the remote control device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of a user's finger (see at least FIGs. 1-2, key 14), *said control keys include an activation key operable to activate*

Art Unit: 2421

the remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 – but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device is considered met by key 14), and said fingerprint sensor is embedded in the activation key (see at least FIGs. 1-2, key 14);

a processor (see at least FIG. 5, device 44) communicatively coupled (see at least 2:23-31) to the remote control device (see at least FIG. 5, device 10), the determining characteristics of the user based upon the fingerprint data (see at least 2:23-31); and

a display (see at least FIG. 5, device 52) providing content to be viewed by the user, the content being customized for the user based upon the characteristics determined by the processor (see at least 2:23-31).

Claim Rejections – 35 USC § 103

7. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 55-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,850,632 to Boyd et al. (“Boyd”) in view of U.S. Patent No. 5,883,680 to Nykerk.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the

Art Unit: 2421

same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

Claim 55

The rejection of base claim 34 is incorporated. Boyd does not specifically disclose the features recited in the claim.

However, in an analogous art, Nykerk discloses *wherein*:

said electronic circuitry is operable to enter a sleep mode if none of said plurality of control keys is operated for a predetermined period of time (see at least 6:53-6:9), and re-activate from said sleep mode upon operation of said activation key and re-acquiring fingerprint data via said fingerprint sensor(see at least 6:53-6:9).

Boyd-Nykerk further discloses *and forget fingerprint sensor data* (Boyd; 2:66-3:2; since Boyd device does not specifically disclose a memory to retain the captured fingerprint, it has to periodically image or sense the fingerprint).

Claim 56

The rejection of base claim 46 is incorporated. Since Claim 56 recites a system comprising the same features of the device claimed in Claim 55, the same rejections are applied.

Claim 57

The rejection of base claim 49 is incorporated. Since Claim 57 recites an apparatus with the same features of the device claimed in Claim 55, the same rejections are thus applied.

Claim 58

The rejection of base claim 52 is incorporated. Since Claim 58 recites a television system with the same features of the device recited in Claim 55, the same rejections are thus applied.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2421

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Monday -Friday from 9:00 – 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist: 571-272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/
Primary Examiner, Art Unit 2421
August 26, 2009